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THOMAS HOXIE
NOVARTIS CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 430/2
EAST HANOVER, NJ 07936-1080

In re Application of :
Mary Ellen Digan et al : PETITION DECISION
Serial No.: 09/480,236 :
Filed: January 10, 2000 :
Attorney Docket No.: 4-30776A

This is in response to the petition under 37 CFR 1.181, filed June 18, 2004, to reverse the examiner's holding of a Non-Compliant Appeal Brief.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on November 21, 2002, setting a three month shortened statutory period for reply. Applicants filed a reply on February 3, 2003, requesting reconsideration. On February 24, 2003, the examiner in an Advisory Action maintained the rejections of record.

Applicants timely filed a Notice of Appeal and then filed a first Appeal Brief on July 16, 2003. On October 10, 2003, the examiner held the Brief to be Non-Compliant for failing to contain a concise explanation of the invention as required by the Rules. On October 15, 2003, applicants filed a second Appeal Brief amending only the concise explanation of the invention. On January 29, 2004, the examiner mailed a second Notice of Non-Complaint Appeal Brief, stating that applicants had failed to indicate why the claims did not stand or fall together.

Applicants filed a third Appeal Brief on March 1, 2004, correcting the statement that the claims did not stand or fall together. The examiner mailed a third Notice of Non-Compliant Appeal Brief on May 18, 2004, stating that applicants had improperly introduced a new reference not of record into the Appeal Brief.

Applicants filed this petition on June 18, 2004, requesting reversal of the examiner's holding of Non-Compliant Appeal Brief. The delay in acting on this petition is regretted, but it was not brought to the attention of the deciding Official until recently.

DISCUSSION

A review of the Notices of Non-Compliant Appeal Brief have been made. There appears to be no reason these Notices could not have been combined into a single Notice. With respect to the

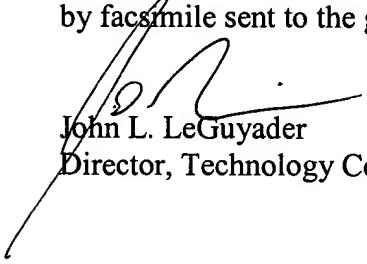
first two Notices, the defects noted in the first two Appeal Briefs are correct and required correction prior to forwarding the application to the Board of Patent Appeals and Interferences. The third Notice states that applicants have improperly introduced a new reference into the Brief. The reference the examiner refers to is Hexham et al. However, the examiner cited this reference on page 3, line 10 of the Final Office action mailed November 21, 2002. Applicants cite and argue this reference on page 6 of each of the Appeal Briefs submitted as required in responding to the rejections of record. Thus the examiner's statement that a new reference is relied upon in the Appeal Brief is in error and the Appeal Brief, as filed March 1, 2004, is accepted as complete and proper.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for immediate preparation of the Examiner's Answer.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



John L. LeGuyader
Director, Technology Center 1600